

REMARKS

INTRODUCTION:

In accordance with the foregoing, claims 1, 4, 7, 11 have been amended and claim 16 has been added. Support for the amended claims and the new claim may be found at least at paragraphs [0005], [0020] and [0023] of the present application, and therefore no new matter has been presented.

Claims 1-16 are pending in the present application. Claims 1, 4, 7, 11 and 16 are independent claims.

REJECTIONS UNDER 35 U.S.C. §112:

Claims 1-15 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. This rejection is traversed and reconsideration is requested.

The Office Action notes that "some of the attributes of pixels are for example intensity, Gamma, etc." The Office Action then asserts the term "pixel level" is unclear. Applicant respectfully disagrees.

The burden is on the Office to articulate a prima facie case as to why one skilled in the art would not understand what is claimed. The Office Action appears to be looking to Applicant to limit the application to a particular attribute out of all of the attributes that may be encompassed by the term pixel value. However, "breadth of a claim is not to be equated with indefiniteness" MPEP § 2173.04 citing *in re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971).

Accordingly, it is respectfully requested these rejections be withdrawn.

REJECTION UNDER 35 USC 103:

Claims 1-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,644,325 (King) in view of U.S. Patent 5,809,366 (Yamakawa). All rejections are respectfully traversed.

Amended independent claim 1 recites at least the following features:

comparing the minimum pixel level value for the selected one R,G, or B component with a predetermined threshold value to determine whether an abnormal R,G, or B component is present, the abnormal R,G, or B component being a component abnormally input due to malfunction of the host

The Office Action notes that King fails to suggest or disclose "comparing the minimum pixel level value for the selected one R, G, or B component with a predetermined threshold value and checking whether an abnormal one R, B, or B component includes an abnormal video

signal. However, the Office Action proposes to modify King with Yamakawa, and asserts that Yamakawa compensates for the deficiencies of King at col. 14, lines 35-38 “wherein RGB data is compared with previous RGB data and correction is based on the results of the comparison.”

Applicant respectfully disagrees. Yamakawa describes analyzing points to determine the exact colors defining the point. Yamakawa further states at col. 14, lines 29-33:

When the colors of these points deviate the expected result by more than an allowable range, it can be determined that the image data was not properly read [sic] or input and a warning for urging the user to execute the scanning again or repeat the process can be displayed.

Yamakawa fails to suggest or disclose, either in the above-recited text or elsewhere, “an abnormal R,G, or B component,” let alone “the abnormal R,G, or B component being a component abnormally input due to malfunction of the host.” Although Yamakawa mentions RGB data at col. 14, lines 35-36, the RGB data in Yamakawa is never linked to the colors of the points described above, or described as including the points. Thus, Yamakawa describes improperly read or input image data but fails to suggest or disclose “determin[ing] whether an abnormal R,G, or B component is present.”

Yamakawa also fails to suggest or disclose “displaying on a screen a message indicating whether the selected one R,G, or B component includes a video signal abnormally input due to the malfunction of the host” as recited in amended independent claim 1.

When the colors described in Yamakawa deviate the expected result, the user is simply warned to “execute the scanning again.” Yamakawa fails to link the deviation to “the selected one R,G, or B component,” nor does Yamakawa provide any indication of any “malfunction of the host.”

Accordingly, Applicant respectfully submits that amended independent claim 1 patentably distinguishes over the cited reference, and should be allowable for at least the above-mentioned reasons. Since similar features recited by each of the independent claims 4, 7, 11, with potentially differing scope and breadth, are not taught or disclosed by the references, the rejection should be withdrawn and claims 4, 7, 11 allowed.

Further, Applicant respectfully submits that claims 2-3, 5-10 and 12-15, which variously depend from independent claims 1, 4, 7, 11, should be allowable for at least the same reasons as claims 1, 4, 7, 11, as well as for the additional features recited therein.

No Motivation to Combine

In *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 127 SCt 1727, 167 LEd2d 705 (U.S. 2007), the U.S. Supreme Court held that in determining obviousness, one “must ask

whether the improvement is more than the predictable use of prior art elements according to their established functions” slip op. 13, 82 USPQ2d at 1396. Furthermore, it is necessary “to determine whether there was an apparent reason to combine the known elements in the fashion claimed” slip op. 14, 82 USPQ2d at 1396.

In rejecting claims 1, 4, 7 and 11, the only reason given for combining King and Yamakawa were:

“to perform minimum pixel level detection and comparison with a predetermined threshold value and thereafter displaying of a screen message as to provide a color balance selection method which allows a user to select the color balance relative to the calibrated standard of an image processing device and therefore reproduce colors contained in a specific image chose by a user and thereby offer an efficient and user friendly device” (Office Action, page 5).

It is submitted that the reason provided is insufficient to answer the question posed by *KSR v. Teleflex*, i.e., whether these claims recite a predictable use of established functions of the devices disclosed in King and Yamakawa. The Office Action cites *In re Oetiker* 977 F.2d 1443 (Fed. Cir. 1992) at page 9, and asserts that a prior art reference “must either be in the field of applicant’s endeavour or, if not, then [must] be reasonably pertinent to the particular problem with which the applicant was concerned.” The Office Action then submits that “Yamakawa teaches color adjusting or calibrating by determining the exact colors.” *Id.* Therefore, other than the conclusory statement that the combination is obvious because it offers “an efficient and user friendly device,” the Office Action fails to provide any evidence as to why the color calibrating techniques of Yamakawa are reasonably pertinent to the particular signal processing problems of King, or whether these claims recite a predictable use of established functions.

In short, Applicants asserts it is unpredictable in the prior art to combine King and Yamakawa in the manner used in rejecting the claims. It is submitted that only the template provided by the claims themselves made the combination of these references seem obvious to the Examiner. Therefore, for at least the above reasons, it is respectfully requested that the outstanding rejections be withdrawn and the presently claimed invention be allowed.

REQUEST FOR INTERVIEW BEFORE NEXT OFFICE ACTION:

Applicant respectfully requests the Examiner contact the undersigned attorney to discuss the pending claims before issuance of the next Office Action. Applicant believes that a more thorough review of the underlying references and the pending claims will be helpful to further prosecution.

NEW CLAIM:

New claim 16 includes at least "comparing the minimum pixel level value for the selected R,G, and B component with a predetermined threshold value to determine whether an abnormal R,G, and B component is present due to malfunction of the host, the abnormal R,G, or B component being a component abnormally input due to malfunction of the host."

Therefore, it is submitted that claim 16 patentably distinguishes over the prior art.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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Date: August 9, 2007

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